

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

HARMAN - BRINKS HOFER CHICAGO Brinks Hofer Gilson & Lione P.O. Box 10395 Chicago IL 60610

## **COPY MAILED**

JAN 2 7 2009

## OFFICE OF PETITIONS

In re Application of :

DAVID H. GRIESINGER : LETTER REGARDING

Application No. 10/810,989 : PATENT TERM ADJUSTMENT

Filed: March 26, 2004

Attorney Docket No. 11336-699:

(P02056US U3C) :

This letter is in response to the "REQUEST FOR REVIEW OF PATENT TERM ADJUSTMENT," filed October 31, 2008. Pursuant to applicant's duty of good faith and candor to the Office, applicant requests that the determination of patent term adjustment under 35 U.S.C. 154(b) be reviewed for accuracy.

The request for review of the initial Determination of Patent Term Adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the notice of allowance is **316 days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On August 8, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment was 346 days. On October 31, 2008, applicant submitted the instant comment.

Applicant requests that the Office recalculate the period of patent term adjustment. Applicant does not state a basis for

applicant's disagreement with the according of 346 days of patent term adjustment.

A review of the application history confirms that applicant should have been assessed a delay under 37 CFR 1.704(c)(8) for the submission of Information Disclosure Statements on October 29, 2007, and November 16, 2007.

#### 37 CFR 1.704(c)(8) provides:

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

It is undisputed that after filing a response on October 17, 2007, applicant filed Information Disclosure Statements on October 29, 2007 and November 16, 2007. The record does not support a conclusion that the examiner expressly requested the Information Disclosure Statements. Further, a review of the Information Disclosure Statements, filed October 29, 2007 and November 16, 2007, reveal that applicant did not include a proper statements under 37 CFR 1.704(d). Thus, applicant failed to engage in reasonable efforts to conclude prosecution of the application.

Pursuant to 37 CFR 1.704(d):

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

Pursuant to 37 CFR 1.704(c)(8), a first period of reduction of 12 days should have been entered, counting the number of days beginning on the day after the date the initial reply was filed, October 18, 2007, and ending on the date that the IDS was filed, October 29, 2007. See 37 CFR 1.704(c)(8). Pursuant to 37 CFR 1.704(c)(8) a second period of reduction of 30 days should have been entered, counting the number of days beginning on the day after the date the initial reply was filed, October 18, 2007, and ending on the date that the second IDS was filed, November 16, 2007.

37 CFR 1.704(c) provides that "[c]ircumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application ... will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping." The first period of reduction of 12 days pursuant to 37 CFR 1.704(c)(8) totally overlaps with the second period of reduction of 30 days. Accordingly, a single period of reduction of 30 days is being entered for these two periods of reduction.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is **316 days** (476 days of Office delay - 160 days of applicant delay).

As this letter was submitted as an advisement to the Office of an error in applicant's favor, the Office will not assess the \$200.00 fee as set forth in 37 CFR 1.18(e). The Office thanks applicant for applicant's good faith and candor in bringing this to the attention of the Office.

Applicant is reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicant will be notified in the Issue Notification letter that is mailed to applicant approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.

Kery A. Fries

Senior Legal Attorney

Kery A. Fres

Office of Patent Legal Administration

Enclosure: Copy of updated PAIR screen

Day: Tuesday Date: 1/27/2009

PALM INTRANET

Time:	09:23:29
-------	----------

PTA Calculations for Application: 10/810989						
Application Filing Date: 03/26/2004	PTO Delay (PTO): 476					
Issue Date of Patent:	Three Years: 0					
Pre-Issue Petitions: 0	Applicant Delay (APPL): 130					
Post-Issue Petitions: 0	Total PTA (days): 316					
PTO Delay Adjustment: -30						

	File Contents History					
Number	Date	Contents Description	PTO	APPL	START	
85	01/27/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		30		
71	08/08/2008	MAIL NOTICE OF ALLOWANCE				
70	08/04/2008	ISSUE REVISION COMPLETED				
69	08/04/2008	DOCUMENT VERIFICATION				
68	08/04/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED				
67	08/04/2008	NOTICE OF ALLOWABILITY				
66	05/20/2008	DATE FORWARDED TO EXAMINER				
65	05/08/2008	RESPONSE AFTER NON-FINAL ACTION				
64	02/08/2008	MAIL NON-FINAL REJECTION				
63	02/04/2008	NON-FINAL REJECTION				
62	10/29/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED				
61	11/16/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED				
59	11/27/2007	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)				
58	11/16/2007	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)				
57	11/16/2007	REFERENCE CAPTURE ON IDS				
56	11/16/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED				
55	10/29/2007	REFERENCE CAPTURE ON IDS				
54	10/29/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED				
53	11/16/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED				
52	10/29/2007	INFORMATION DISCLOSURE STATEMENT (IDS)				

	1 1	FILED			
51	10/22/2007	DATE FORWARDED TO EXAMINER			
50	10/17/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
47	10/22/2007	DATE FORWARDED TO EXAMINER			
46	10/17/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)		61	41
45	10/22/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
44	10/17/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
43	06/13/2007	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
42	805/31/2007	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
41	05/17/2007	MAIL FINAL REJECTION (PTOL - 326)			
40	05/14/2007	FINAL REJECTION			
39	11/01/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
38	03/06/2007	DATE FORWARDED TO EXAMINER			
37	02/21/2007	RESPONSE AFTER NON-FINAL ACTION		69	34
36	02/21/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
35.7	11/01/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
35	11/01/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			·
34	09/14/2006	MAIL NON-FINAL REJECTION	476		-1
33	08/21/2006	NON-FINAL REJECTION			
32	05/13/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
31	01/09/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
30	08/08/2006	CASE DOCKETED TO EXAMINER IN GAU			
29	03/21/2006	CASE DOCKETED TO EXAMINER IN GAU			
-28	01/09/2006	REFERENCE CAPTURE ON IDS			
27.7	01/09/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
27	01/09/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
26	06/06/2005	CASE DOCKETED TO EXAMINER IN GAU	<u> </u>		
25	05/25/2005	CASE DOCKETED TO EXAMINER IN GAU	<u> </u>		

l	اء ممدد میدا	OLOR DOCKETED TO THE ALCOHO	11		ı ıl
		CASE DOCKETED TO EXAMINER IN GAU	<del> </del>		
		CASE DOCKETED TO EXAMINER IN GAU	<u> </u>	<u> </u>	
		CASE DOCKETED TO EXAMINER IN GAU	<u> </u>		
21	02/11/2005	CASE DOCKETED TO EXAMINER IN GAU	<u> </u>		
20		IFW TSS PROCESSING BY TECH CENTER COMPLETE			
19	05/13/2004	REFERENCE CAPTURE ON IDS	]		
18.7	05/13/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
18		INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
17	11/10/2004	CASE DOCKETED TO EXAMINER IN GAU			
16	06/07/2004	APPLICATION RETURN FROM OIPE			
15	06/07/2004	APPLICATION RETURN TO OIPE			
14	06/07/2004	APPLICATION RETURN FROM OIPE			
13	06/08/2004	APPLICATION IS NOW COMPLETE			
12	06/08/2004	PRE-EXAM OFFICE ACTION WITHDRAWN			
11	06/07/2004	APPLICATION RETURN TO OIPE			
10	06/07/2004	APPLICATION RETURN FROM OIPE			
9	06/08/2004	APPLICATION IS NOW COMPLETE			
8	06/08/2004	PRE-EXAM OFFICE ACTION WITHDRAWN			
7	06/07/2004	APPLICATION RETURN TO OIPE			
6	06/07/2004	APPLICATION DISPATCHED FROM OIPE			
5	06/08/2004	APPLICATION IS NOW COMPLETE			
4	04/23/2004	CLEARED BY OIPE CSR			
3	04/23/2004	CASE CLASSIFIED BY OIPE			
2	04/16/2004	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	03/26/2004	INITIAL EXAM TEAM NN			

Search Another: Application# Search

# **EXPLANATION OF PTA CALCULATION**

### **EXPLANATION OF PTE CALCULATION**

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to OASIS | Home page